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09/25/2003

John C. Huculak

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IP LEGAL, TB4-8

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EXAMINER

JOHNSON III, HENRY M

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/671,150  
Filing Date: September 25, 2003  
Appellant(s): HUCULAK ET AL.

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Jonathan E. Prejean  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 17, 2009 appealing from the Office action mailed September 26, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

Art Unit: 3769

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(4) Status of Amendments After Final**

The statement of the status of claims contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,436,035	Toth et al.	8-2002
6,211,626	Lys et al.	4-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,436,035 to Toth et al. in view of U.S. Patent 6,211,626 to Lys et al. Toth et al. teach an intensity controlled hand-held surgical light source for use in ophthalmic surgical procedures (Col. 1, lines 9-14). The handpiece houses a light source (Fig. 2, # 22) and battery (Fig. 2, # 20) and a delivery portion (Fig. 2, # 16). The delivery portion is interpreted as a cannula. Clearly the cannula has distal and proximal ends and the handpiece must be hollow to house the components. The intensity of the emitted light is controlled by a switch (Fig. 2, # 26-1) and

Art Unit: 3769

control circuitry (Fig. 2, # 24), with the switch controlling the intensity in a step-wise manner in response to the switch closure (Col. 4, Lines 25-26). Toth et al. do not disclose an LED source mounted at the distal light delivery end of the device or wireless control of the intensity. Lys et al. disclose a plethora of illumination configurations using light emitting diodes mounted at a distal end of a medical apparatus (Figs. 93B-94). Configurations for illumination of body cavities are disclosed (Fig. 93C). The LED system is disclosed as capable of being used to illuminate the retina for ophthalmological examination. (Col. 68, lines 33-35). Lys et al. teach that incandescent sources may produce undesirable heat. Such sources may have very limited life spans. Conventional light sources may require substantial lens and filtering systems in order to produce color (Col. 5, lines 19-22). Thus, Lys et al. teach benefits of using an LED light source that are not unique to a specific application. A skilled artisan would readily recognize the benefits of using LEDs in the device of Toth et al. in not only the head reduction, but also in the elimination of the optics and the associated costs. The reduction in size and power requirements are well known for LEDs yielding additional benefits and motivation for using LEDs over an incandescent source. Lys et al. further teach RF or infrared signals (wireless) for remote control of light devices (Col. 46, line 63 to Col. 47, line 15). Inherently, remote control requires a receiver and transmitter combination. The use of remote controls is a generic technology that would be considered by a skilled artisan based on the device, intended use and common sense. It would have been obvious to one skilled in the art to incorporate wireless control and LED sources as taught by Lys et al. in the device of Toth et al. as the enhancements represent technological advancements that transcend specific devices and are pervasive in today's society.

"If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a

Art Unit: 3769

person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. Sakraida and Anderson's-Black Rock are illustrative. A court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." (KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL.; SUPREME COURT OF THE UNITED STATES, No. 04-1350; ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT; April 30, 2007).

#### **(10) Response to Argument**

Applicant's argument that Lys et al. do not disclose the configuration cited in the claim is irrelevant. The combined teachings of Lys et al. and Toth et al. must meet the claim limitations. Since Lys et al. is used as a teaching for essentially using LEDs in place of incandescent light sources and for remotely controlling a light source, it need not meet the claimed configuration. The device of Toth et al. as modified by Lys et al. would meet the claimed configuration. The combination must be considered, not the individual references.

To interpret a skilled artisan's use of the well known technologies of LED light sources and wireless control as hindsight is not appropriate. These generic items have known benefits that would routinely be considered and investigated for use in light devices. Lys et al. explicitly teach the benefits. (KSR, 127 S. Ct. at 1742, 82 USPQ 2d at 1390) states "Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already

Art Unit: 3769

known.” The reasons for using LEDs and wireless are clearly taught by Lys et al., not from the instant application.

Lys et al. clearly and explicitly states the benefits of LED light sources over an incandescent light source, thus providing solid motivation to use solid state light sources. The benefits (convenience) of wireless control are extremely well known considering the pervasiveness of these devices and a person of ordinary skill in the art could most certainly implement a predictable use of this prior art element according to its established functions. Since the teachings of Lys et al. are generic in nature, the question is not if Lys et al. is rendered unsuitable, but if Toth et al., with the modifications of the teachings of Lys et al. are able to perform its intended use. The answer is clearly, yes.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Henry M. Johnson, III/

Supervisory Patent Examiner, Art Unit 3769

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TQAS, TC 3700